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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/785,214
Filing Date: February 24, 2004
Appellant(s): BURCHETTE, ROBERT LEE

J. Herbert O' Toole
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/04/2008 appealing from the Office action mailed 8/22/07

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix is a mark up version and is improper. A clean copy of the claims is attached.

(8) Evidence Relied Upon

6100811	**Hsu et al.**	**08-2000**

6927671	**Debono**	**08-2005**
2004/0155752	**Radke**	**08-2004**
5668929	**Foster, Jr.**	**09-1997**
6473607	**Shohara et al.**	**10-2002**
6078265	**Bonder et al.**	**06-2000**
6727800	**Dutu**	**04-2004**

International Patent Publication WO 02/091311

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 19, 20, 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu et al. US Patent 6100811 in view of DeBono US Patent 6927671 and further in view of Radke US Patent Application Publication 20040155752.

Regarding claim 19, Hsu et al. teach a device to provide fingerprint access to the interior of a vehicle comprising;

a protective housing including a fingerprint sensor 14 mounted on the exterior of the vehicle (figure 2) (col. 4 lines 42-45);

a wired means for connecting the fingerprint sensor 14 to an electric circuit (30) for storing and verifying electronic fingerprint information (col. 4 lines 54-57);

means (34) to activate a device (door) to allow access control upon verification of electronically stored fingerprint information (col. 4 lines 61-65). Hsu et al. is silent on teaching a rigid hinged cover, means for switching the circuit from a low-power sleep state to a higher-power active state for enabling the fingerprint sensor to acquire the fingerprint, and is also not explicit in teaching means for connecting the sensor to a power source. DeBono in an art related biometric vehicle control system teaches a biometric sensor protected by a flip cover (col. 7 lines 10-15). A flip cover is considered a hinged cover. DeBono further implied that the flip cover for the biometric sensor is rigid because a flexible material is not convenient for flipping. Radke in an art related fingerprint reader invention teaches a fingerprint sensor connected to a power supply (figure 12) and teaches means for switching the circuit from a low-power sleep state to a higher-power active state for enabling the fingerprint sensor to acquire the fingerprint (paragraph 0032).

It would have been obvious to one of ordinary skill in the art to modify the fingerprint system of Hsu et al. as disclosed by Debono in view of Radke at the time the invention was made because a hinged cover protect the fingerprint sensor and provides easy access to the fingerprint sensor. The means for switching the circuit from a low-power sleep state to a higher-power active state provides the means to conserve the power supply of the fingerprint sensor.

Regarding claim 20, Hsu et al. teaches the fingerprint sensor is housed in the protective housing of the door handle (col. 4 lines 33-36) and the fingerprint sensor is sealed as shown in figure 3.

Regarding claim 23, Hsu et al. teaches a switch to activate the electronic circuit (col. 4 lines 62-67).

Regarding claims 24-25, Hsu et al. teaches means such as ignition switch, climate control, and seat adjuster for selecting the function (figure 5).

Regarding claim 26, Hsu et al. teaches the electronic circuit (30) for storing and verifying the fingerprint is with the protective housing provided by the vehicle (col. 4 lines 55-57).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu et al. US Patent 6100811 in view of DeBono US Patent 6927671 in view of Radke US Patent Application Publication 20040155752 and further in view of Foster, Jr. US Patent 5668929.

Regarding claim 17, Hsu et al. teaches a fingerprint sensor for receiving a fingerprint (see response to claim 19) and the reference of DeBono teaches a backup battery for powering the biometric controlled system in case of the vehicle battery failure and also teaches the battery is useable as a primary source (col. 9 lines 64-67). The use of the backup battery as the primary source implied that the battery is used to operate the vehicle and the backup battery therefore has sufficient capacity to enable a vehicle to start when a main battery has been discharged. DeBono is however not explicit in teaching the backup battery is rechargeable. It is also the examiner's

position that the rechargeable battery are conventionally used in a vehicle for powering the vehicle when the vehicle is not in motion. Foster, Jr. in an art related security system invention teaches the use of a rechargeable backup battery for providing power (col. 8 lines 51-60) in order to extend the life of the battery.

It would have been obvious to one of ordinary skill in the art to modify the fingerprint system of Hsu et al. as disclosed by DeBono in view of Foster, Jr. because the backup battery allows the vehicle to be accessed in the case when the vehicle main power supply is exhausted and the use of a rechargeable backup battery extends the life of the battery.

Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu et al. US Patent 6100811 in view of DeBono US Patent 6927671 in view of Radke US Patent Application Publication 20040155752 and further in view of Carta International Publication WO 02/091311.

Regarding claims 28-29, Hsu et al. teaches a fingerprint sensor for receiving a fingerprint (see response to claim 19) but is silent on teaching a radio frequency shuttle card containing the fingerprint information. Carta in an art related biometric access control system teaches shuttle card in the form of a radio frequency smart card storing biometric data (abstract).

It would have been obvious to one of ordinary skill in the art to modify the fingerprint system of Hsu et al. in view of DeBono in view of Radke as disclosed by Carta because smart card provides a convenient and cost effective means for storing and transporting the identification data necessary for operating a biometric access control system.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Radke US Patent Application Publication 20040155752 in view of Shohara et al. US Patent 6473607.

Regarding claim 30, Radke teaches conserving energy to a fingerprint reader by entering a sleep mode after a predetermined amount of time after detecting a fingerprint and re-energizing the fingerprint sensor when a finger is detected (paragraph 0033-0034). Radke teaches a switch for re-energizing the fingerprint sensor (paragraph 008) but is however not explicit in teaching a clock which counts the time since the last input into the electronic circuit. The use of a counter to count the time since the last input for determining the timeout period is a conventional practice and is further evidenced by Shohara et al. (col. 6 lines 17-29).

It would have been obvious to one of ordinary skill in the art to provide a counter to count the time since the last input into the electronic circuit in Radke because this allows the user to control how soon the device enters the sleep mode after its activation period.

Claims 34, 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu et al. US Patent 6100811 in view of DeBono US Patent 6927671 in view of Radke US Patent Application Publication 20040155752 and further in view of Bonder et al. US patent 6078265.

Regarding claims 34-38, Hsu et al. teaches enrolling new user fingerprint (col. 2 lines 35-42), a starter interlock for preventing the actuation of the ignition without a valid fingerprint (col. 6 lines 50-60) but is silent on teaching a password protected detachable enroller. Bonder et al. in an art related fingerprint security system teaches the use of a password protected detachable programming unit for programming new fingerprint (col. 5 lines 20-22).

It would have been obvious to one of ordinary skill in the art to have a password protected enrollment device because this enables the addition of new users to the fingerprint protected system and further ensure that the enrollment device is operated by an authorized person.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu et al. US Patent 6100811 in view of DeBono US Patent 6927671 in view of Radke US Patent Application Publication 20040155752 in view of Bonder et al. US patent 6078265 and further in view of Dutu US Patent 6727800.

Regarding claim 35, Hsu et al. teaches a fingerprint sensor for receiving a fingerprint (see response to claim 19) but is silent on teaching a shuttle card containing the fingerprint information. Dutu in an art related fingerprint security system teaches a card reader and the use of shuttle card in the form of a smart card that includes a chip to store a fingerprint template (col. 4 lines 46-55).

It would have been obvious to one of ordinary skill in the art to modify the fingerprint system of Hsu et al. in view of DeBono in view of Radke in view of Bonder et al. as disclosed by Dutu because the smart card ensures that the vehicle will only operate when the smart card is installed in the reader of the vehicle And therefore increase the security of the vehicle.

(10) Response to Argument

Appellant argues on page 9 that the biometric sensor as disclosed by Hsu does not have a protective cover. It is the examiner's position that the reference of Hsu teaches a fingerprint sensor 14 is mounted on the underside of the exterior door handle of the vehicle (col. 4 lines 42-

45) and the door handle therefore provides a protective cover for the sensor located on the underside of the door handle. The reference of DeBono is further relied upon for teaching a biometric sensor protected by a flip cover (col. 7 lines 10-15). A flip cover is considered a hinged cover.

Appellant argues on page 9 that the biometric sensor cover as disclosed by DeBono represents a decorative cover. It is the examiner position that the flip cover as disclosed by DeBono represents a protective cover (abstract). It is also the examiner's position that one skilled in the art recognizes that a fingerprint biometric sensor must be covered in order to be protected dirt and other environmental conditions.

Appellant argues on page 9 that the biometric fingerprint sensor as disclosed by DeBono is located in the cabin and is not outside of the vehicle. It is the examiner's position that the reference of Hsu teaches locating the biometric fingerprint sensor inside and outside of the vehicle (figure 2, figure 4) and the fingerprint sensor is placed based on the system to be controlled.

Appellant argues on page 10 that the housing of the sensor is preferably located at the base of the windscreen. It is the examiner's position that this limitation is not claimed.

Regarding appellant argument on page 10 regarding the reference of Radke, the reference of Radke is qualified prior art under 102(e) and the fact that a Patent was not granted for this application does not disqualify this publication as a prior art.

Appellant argues on pages 10-11 that the wrong standard of obviousness is being applied to the rejection of the claims there is no motivation to combine the reference of Hsu et al. and DeBono. It is the examiner's position that it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The reference of Hsu teaches a fingerprint sensor 14 is mounted on the underside of the exterior door handle of the vehicle (col. 4 lines 42-45) and the door handle therefore inherently provides a protective cover for the sensor located on the underside of the door handle. One of ordinary skill in the art recognizes that an exposed fingerprint sensor accumulates dirt and prevent the detection of a clear fingerprint. The reference of DeBono is further relied upon for teaching a biometric sensor protected by a flip cover (col. 7 lines 10-15). The flip cover as disclosed by DeBono represents a protective cover (abstract). The motivation for combining the reference of Hsu and DeBono is therefore provided by the references and the knowledge available to one of ordinary skill in the art.

Appellant argues on pages 10-11 that the reference of Hsu and DeBono teaches away from the sensor having a protective cover. It is the examiner position that the references of Hsu and DeBono provides no disclosure that discourages the use of a protective cover and therefore does not teach away from the use of protective cover by the biometric sensor.

Regarding appellant's argument regarding the use of a rechargeable backup battery, it is the examiner's position that the reference of DeBono teaches a backup battery for powering the biometric controlled system in case of the vehicle battery failure and also teaches the battery is useable as a primary source (col. 9 lines 64-67). The use of the backup battery as the primary source implied that the battery is used to operate the vehicle and therefore has sufficient capacity

to start the vehicle. It is also the examiner's position that rechargeable battery are conventionally used in vehicles for powering the vehicle when the vehicle is not is motion.

Regarding appellant argument regarding claims 28-29, the reference of Carta teaches the use of a shuttle card in the form of a radio frequency smart card storing biometric data and shuttle card is used for programming an access control device (abstract). The validation of the card as argued provides the means for authenticating the shuttle card.

Appellant argues on page 14 that the reference of Bonder fails to teach or suggests a password protected reader. It is the examiner position that the reference of Bonder teaches the use of a password (personal identification number) protected detachable programming unit for programming new fingerprints (col. 5 lines 20-22).

Regarding appellant's argument regarding the aftermarket limitation recited in claim 19, It is examiner's position that the recitation of an aftermarket device has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. The functionality or the of the biometric sensor is not changed based on whether it is an aftermarket or OEM device. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Appellant's argument on page 14 that a fingerprint activated and activation system installed as an assembly line item is specific for a manufacture (OEM) that can be disabled but not removed from the vehicle is not persuasive because removal is not a claimed limitation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Vernal Brown

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